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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,951	09/20/2000	Friedhelm Beckmann	2641/207-168	7347

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EXAMINER
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MANLOVE, SHALIE A

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 09/23/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

ms. 14

# Office Action Summary

Application No.

09/666,951

Applicant(s)

BECKMANN, FRIEDHELM

Examiner

Shalie A. Manlove

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Information Disclosure Statement*

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Rejections Repeated*

2. The 35 U.S.C. § 112, first paragraph rejections of claims 1-3, 10 and 15 are repeated for reasons previously of record in paper 13, page 2, paragraph #2.

3. The 35 U.S.C. 112, second paragraph rejections of claims 1-18 are repeated for reasons previously of record in paper 13, page 2, paragraph #4.

Applicant argues that, "the activatable material disclosed in the specification refers to material which is activatable to foam, and if activated, form foam. In other words, the activatable material disclosed in the specification is activatable foamable material".

**The activatable foamable material is not clearly taught so that one of ordinary skill in the art would recognize the substance known as the activatable foamable material.**

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**Specific materials are neither identified in the specification nor claimed. Claims directed to materials characterized by physical properties alone and no specific composition are vague, indefinite and invalid. Ex parte Slob 157 USPQ 172**

4. The 35 U.S.C. 103 rejections of claims 1-14 over Thum (US 5194199) in view of Soderberg (US 5160465) are repeated for reasons previously of record in paper ~~13~~<sup>12</sup>, page 4, paragraph #8.

With respect to Applicant's argue that, Soderberg does not teach the step of "subjecting all interior areas of the assembly to a corrosion protection agent". Additionally, the Applicant argues, " if the interior areas of the assembly in Soderberg would be subject to anti-corrosion treatment, then it would not be necessary to use a non-moisture-absorbing foam to minimize corrosion".

**Soderberg discloses submitting the vehicle to low temperature anti-corrosion treatment (col. 3, lines 1-10). The examiner deems the vehicle to contain an interior and an exterior, thus by submitting the vehicle to treatment; one would be applying treatment to the exterior as well as the interior.**

**With respect to the non-moisture-absorbing foam disclosed by Soderberg, it would be obvious to one of ordinary skill in the art to use non-moisture-absorbing foam in order to prevent the introduction of moisture from any source into the process.**

5. In response to the Applicant's argument that there is no suggestion to combine the references, **the examiner recognizes that references cannot arbitrarily combined and that**

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**there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975)**

**The test for combining is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin 170 USPQ 209 (CCPA 1971)**

**In this case the references combined disclose a hollow section with internal reinforcement as is similarly presented in the instant application. The Examiner deems the references applicable as prior art in respect to the Applicant's invention.**

***Withdrawn Rejections***

6. The 35 U.S.C. 102 rejections of record in paper ~~13~~<sup>12</sup>, page 3, paragraph #6 have been withdrawn due to Applicant's amendment in paper #13.

7. Applicant's arguments with respect to claims 15-18 have been considered but are moot in view of the new ground of rejection.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thum (US 5194199) and Soderberg (US 5160465) in view of Russell (WO 93/05103).

Thum discloses a beam like structural part having a core of lightweight material comprising polyurethane or aluminum foam (fig.1, col. 2, lines 17-19) and Soderberg teaches a process of insulating a body by submitting the body to anti-corrosion treatment and then to a high temperature curing treatment whereby the foaming material expands and adheres to the surrounding metal surface and forms a sound and moisture insulating plug of closed-cell foam (col.3, lines 2-10). Neither Thum nor Soderberg teach the activatable material to be a foamed/unfoamed metallic material, or synthetic material reinforced with fibers.

However, Russell teaches the activatable material to be a mixture of plastics material and reinforcing fibers (page 1, lines 34-39) for the purpose of reinforcing a structure. In addition the reference teaches strengthening only in some areas for the purpose of structural integrity (page 3, lines 6-7).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the structural body of Thum, comprising a hollow member for insulation, with the process of insulating the body as taught by Soderberg with the activatable foamable material and the method of

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strengthening portions as taught by Russell to create a body comprising a hollow section that has internal reinforcement in full or parts in order to improve the performance of the structure.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shalie A. Manlove whose telephone number is (703) 308-8275. The examiner can normally be reached on M-F 8:00- 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (703) 308-3823. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Shalie A. Manlove

Examiner

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September 21, 2002



Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700